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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,883	02/04/2004	Peter Tews	COH-15303	3749
40854	7590	08/08/2005	EXAMINER	
RANKIN, HILL, PORTER & CLARK LLP 4080 ERIE STREET WILLOUGHBY, OH 44094-7836			YEE, DEBORAH	
			ART UNIT	PAPER NUMBER
			1742	

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/771,883

Applicant(s)

TEWS, PETER

Examiner

Deborah Yee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. Claim 22 provides for the use of a platinum alloy for manufacturing an ornamental article, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 22 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Same rejection above also applies to claim 39 as being an improper "use" claim.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 23 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese patent 404087260, Kretchmer (US Patent 6,869,567) or Japanese patent 359143032.

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4. Each reference teaches a platinum alloy containing one or more non-precious elements which meet the recited claims. See JP'260 specific examples C-6 and C-4 in Table 1 and C-17 in Table 2 on page 352; Kretchmer, line 1 of column 4; and JP'032 examples 4 and 19 on page 163.

5. Even though JP'260 does not teach a jewelry product as recited by claim 26, such would not be a patentable difference since using the product for jewelry is merely applicant's future and intended use.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 to 8, 11 to 21, 24,25, 27 , 28 and 31 to 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese patent 404087260.

8. The English abstract of JP'260 discloses a platinum alloy containing cobalt and copper in wt% ranges (when converted from atomic%) that overlap those recited by the claims ; such overlap establishes a prima facie case of obviousness.

9. More specifically, note example C-6 in Table 1 on page 352 containing in wt% 70%Pt-9.46Co-9.4Ni-10Cu and example C-17 containing 79% Pt-11.5%Co-12.4%Cu which closely meet the claims. Since applicant has not demonstrated (e.g. by comparative test data) that the more narrowly claimed alloy ranges are somehow critical

and productive of new and unexpected results, then claims would not patentably distinguish over prior art.

10. Even though prior art alloy may additionally contain Ni, such would not be excluded by the claims reciting "comprising". Note that the term comprising is inclusive of all unrecited elements, even in major amounts. Also note JP'260 in Table 2 on page 352 discloses examples that do not contain Ni.

11. Also note that JP'260 alloy discloses a platinum alloy having alloying constituents that overlap those recited by the dependent claims.

12. Even though JP'260 does not teach the hardness, tensile strength, elongation, and color tone recited by one or more of the dependent claims, such would be expected since compositional limitations are closely met, and in absence in proof to the contrary.

13. Even though prior art does not teach an ornamental article as recited by one or more of the dependent claims, such would not be a patentable difference since it is merely applicant's future and intended use.

14. The method of making alloys by blending, melting and casting as recited by one or more claims is conventional and a standard technique of making alloys; and hence would be expected or obvious to incorporate in the making the JP'260 alloy.

15. Claim 24 recites 58.5% Pt and claim 25 recites 75% Pt which are within the JP'260 platinum wt% range.

16. Claims 9,10,29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese patent 404087260 as applied to claims 1 to 8, 11 to 21,24,25,27,28 and 31 to 39 above, and further in view of Japanese patent 356029641.

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17. JP'260 closely meets the composition recited by claims 9, 10, 29 and 30 except fails to include small amounts of rare earth elements, such as Pd, Ir Ru, In and/or Ga. It is, however, well known in the art as evident by the English abstract of JP'641 that these elements are added to Pt alloys to further enhance strength and hardness. Since strength and hardness would be desirable properties sought by JP'260, then it would be an obvious modification well within the skill of the artisan to incorporate into its alloy to produce no more than the known and expected effect of such an addition.

18. Claims 2,5,6, 24, 25 and 27 to 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese patent 356029641 or Japanese patent 359143032.

19. The English abstract of JP'641 and JP'032, each teach a platinum alloy with constituents whose wt% ranges overlap or closely approximate those recited by claims 2,5,6,27,28,34 to 37; such similarities establishes a prima facie case of obvious because it would be obvious to one of ordinary skill in the art to select the claimed alloy ranges from the broader disclosure of the prior art because the prior art has the same utility (ornamental and decorative articles), see MPEP 2144.05.

20. It should be noted that JP'641 discloses a lower limit of 80% Pt whereas the present invention requires a minimum of 79.5%Pt. Since applicant has not demonstrated of the Pt range (e.g. by comparative test data), then it would seem that a composition with 79.5% Pt vs. a composition with slightly more (say 80%) Pt would depict a mere difference in the proportion of element without any attendant unexpected results, which would not patentably distinguish claims over prior art.

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21. Moreover, even though JP'260 does not teach the hardness, tensile strength, elongation, and color tone recited by one or more of the dependent claims, such would be expected since compositional limitations are closely met, and in absence in proof to the contrary.

22. The steps of making alloys by blending, melting and casting as recited by the method claims are conventional and standard technique for making alloys; and hence would be expected or obvious to incorporate in the making the JP alloys.

23. The English abstract of JP'032 discloses a Pt wt% which would encompass the 58.5% recited by claim 24 and 75% recited by claim 24 and also contain one or more precious metals.

24. The English abstract of JP alloys contain Pd, Ir, and/or Ru in wt% ranges that overlap claim 29.

25. The prior art alloys contain rare earth elements which would include In and/or Ga as recited by claim 30 since these element are part of the rare earth metal family in the periodic table. Also wt% ranges are overlapping.

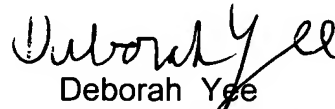
26. The prior art English abstract discloses using alloy for making ornamental articles which meet claims 36,37 and 39.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is 571-272-1253. The examiner can normally be reached on Monday-Friday from 6:00 to 2:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Deborah Yee  
Primary Examiner  
Art Unit 1742

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